

REMARKS

Applicants and applicants undersigned representative appreciates the courtesies extended by Examiner Garland and his supervisor, Mr. Picard, during a personal interview conducted on April 28, 2003, in which the undersigned and the undersigned's associate, Mr. Robins, attended the interview, together with Mr. Satchell, one of the applicants.

During the aforementioned interview, the matters of amendments to address the 35 U.S.C. §112 rejections was mentioned, together with an extensive discussion of the effective prior art dates of the cited references, the issue of recapture and the matter of submitting Declarations under 37 C.F.R. §1.131 to overcome the cited prior art. As to any prior art not overcome, a discussion of the differences of the prior art, especially that of the cited Peters patent, was conducted. A further Summary of the Interview can be found in the Interview Summary Record incorporated herein by reference.

Turning now to the specific matters listed in the Office Action, applicants appreciate the allowance of original claims 1-12 and the indication of allowability in claim 75. However, by the accompanying Amendment and Remarks, together with the Exhibits and other attachments, applicants respectfully submit that claims 31-41, 60-74 and 76-130 are also in condition for immediate allowance.

With regard to the rejection under 35 U.S.C. §112, second paragraph, of claims 37-38, 41, 95 and 102-103, applicants have amended claims 37-38, 41 and 102 to provide proper antecedent basis for the claimed limitations and/or to correct grammar. Dependent claims 95 and 103 are accordingly corrected by the amendment of the claims upon which they depend. Support for the

amendments can be found in the claims upon which they depend. Support for the amendment of claim 114 can be found in the original disclosure, for example, column 4, lines 17-18; 49-52; and column 5, lines 31-35 and support for access portal (previously amended) can be found throughout the specification; See, for example, "access" at column 4, lines 41; line 53-56; column 5, lines 12-17; 20-25 and 43-44, as well as column 7, lines 41-43 and Fig. 6. The classic definition of "'portal' is a door" . . . ; See, Newton's Telecom Dictionary, page 694. "In the Internet/world wide web a portal is a site which the owner positions . . . as an entrance to other sites or the Internet." Id. Such "portal" is shown in Figs. 1-3 and 6 and column 4, lines 53-56; column 5, lines 7-46; column 7, lines 23-32, lines 41-43 and column 10, lines 23-26.

RECAPTURE

Claims 114-130 stand rejected under 35 USC §251, allegedly as being an improper recapture of broadened subject matter surrendered in the application for the patent upon which the present reissue is based. Applicants respectfully traverse this rejection.

Firstly, applicants point out that Application Serial No. 08/715,232 never contained nor was it amended to contain any method claims. Thus, there was no cancellation of subject matter involving steps as in presently recited claims 114-130. The subject matter to which the Examiner's comments in the rejection are directed all refer to apparatus limitations which find no identifiable correspondence in the rejected method claims 114-130. Stated another way, were the original (not amended) claims of the 08/715,232 identical to the present method limitations of claims 114-130 such as to form the basis of a statutory double patenting rejection under 35 U.S.C. §101 under the

standard of *In re Vogel*, 422 F.2d 438; 164 USPQ 619 (CCPA 1970), if contained in different applications? The answer is clearly that they were not. How, then, can any amendment to apparatus claims that were not identical to the present method claims be suggested to be a surrender of subject matter of method claims allegedly being recaptured in the present claims 114-130. The Examiner's comments as to recapture also fails to take into consideration that claim 12 of the patent was never subject to a prior art rejection and was never amended during prosecution, having been indicated allowable in the first office action. Recapture, as that term is understood from the authorities cited by the Examiner in support of his rejection requires the surrender of subject matter. As claim 12 did not surrender any subject matter, there can be and is no prohibition against broadening this claim as the present reissue was filed within the two year limit imposed by 35 U.S.C. §251. Such a broadening could omit any limitation in original claim 12, including the recitation that the door is for "retrofitting an existing" vending machine. Thus, there is no legal basis for prohibiting either broadening of claim 12 or for submitting claims 114-130 which find no direct correspondence in any original or final claim in the 08/715,232 application. MPEP Section 1412.02 to which the Examiner refers applicants support this conclusion.

The Two Step Test for Recapture annunciated by the Federal Circuit in *In re Clement*, 131 F.3d 1464, 45 USPQ 1161 (1997) requires not only that the Examiner determine whether and in what aspect the reissue claims are broader than the patent claims (Step 1), but also to determine whether the broadened aspects relate to surrendered subject matter (Step 2). Applicants respectfully submit that the Examiner, although attempting to determine the difference between the present claims and the claims of the patent, fails to appreciate that rejected claims 114-130 are directed to

a different statutory class of invention and, thus, to subject matter not claimed in the original application and, furthermore, the Office Action lacks consideration of the second step, i.e., that no subject matter was surrendered with regard to either claim 12 of the patent or to this unclaimed subject matter directed to the statutory class of invention known as "process" (method) and that such claims can, thus, be broadened within the two year time limit of 35 U.S.C. §251.

The absence of claims to a different statutory invention, e.g., process (method) claims, is an error commonly made without deceptive intent both by applicants and their attorneys and forms for the basis for reissue applications.

The present application was filed within two years of the patenting of U.S. Patent 5,822,216 and claimed subject matter that was omitted from the original claimed subject matter, e.g., the method claims, arose through inadvertence and without deceptive intent (See Reissue Declaration). Specifically, the claims 114-130 presented for examination are directed to "a method," whereas the subject matter of the originally allowed claims in the '216 patent were directed to an article of manufacture. Thus, although the instant method claims are a permissive "broadening" of the original claimed invention, they are not necessarily barred by failing to include all the limitations of the previously allowed article of manufacture.

In this regard, applicants respectfully direct the Examiner's attention to the Federal Circuit's Decision in *Scripps Clinic and Research Foundation v. Genetic, Inc.*, 18 USPQ 2d 1001, 1009 (1991), citing *Balcorp v. The United States*, 221 USPQ 289, 296, note 28 "the purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive" and "the reissue statute 'is based on fundamental principals of equity and fairness.'"

When the statutory requirements are met, reissuance of the patent is not discretionary with the Commissioner, it is mandatory ("shall") citing *In re Handle*, 136 USPQ 460, 464 (CCPA 1963).

Continuing, the *Scripps* court stated "the law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue." The failure of the attorney to claim the invention sufficiently broadly is "one of the most common sources of defects" citing *In re Wilder*, 222 USPQ 369 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985).

On undisputed facts, the inventor established that he had claimed less than he had a right to claim, that he had done so in error, and that there was no deceptive intention.

In the *Scripps* case, the reissue added a different statutory basis of claims, i.e., chemical product claims (claims 24-29) which were added to the reissue patent (See, generally, footnote 1 of *Scripps* at 1003 and the history of the *Scripps* reissue related in *Scripps Clinic and Research Foundation v. Genetic, Inc.*, 3 USPQ 2d 1481, 1484 (ND California 1987)).

In accord, the examiner's attention is directed to *CR Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ 2d, 1225, 1234 (Fed. Cir. 1998) in which defendant M3 Systems argued that the original patent was not amendable to correction by reissue because of the addition of claims to an article of manufacture, i.e., needles *per se*, whereas the original invention was directed to a biopsy needle firing device or "gun" mechanically injecting a biopsy needle assembly into body tissue. Here the court states, "for a primary purpose of the reissue statute is to enable the addition of claims to subject matter not claimed in the original patent (citing *Scripps, supra*) (emphasis added).

The defendant M3 Systems argued that since the needles were not claimed originally, they were not "intended" to be claimed and that absence of such intent is not an error correctable by

reissue. The court found that "that too is incorrect statement of the law." "An inventor's failure to appreciate the scope of an invention at the time of the original patent grant, and thus an initial intent not to claim the omitted subject matter, is a remedial error" (citations omitted).

The reissue applicants here had not presented original method claims in the application which matured into the patent undergoing reissue. They have stated through their Reissue Declaration that without deceptive intent, they claimed less than they had a right to claim. Clearly, they have complied with the reissue statutes and should be permitted to present and obtain allowance of claims in the reissue application pursuant to 35 U.S.C. §251 to a statutory class of invention not originally contemplated in the original application maturing into the patent undergoing reissue.

For the foregoing reasons, reissue applicants respectfully requests withdrawal of the rejection based on 35 U.S.C. §251.

ANTEDATING THE PRIOR ART

Applicants thank the Examiner for his referral to MPEP § 706.021(1) - 706.021(3) in regard to 35 U.S.C. §103(c). In response, attached is a declaration submitted under 37 C.F.R. §1.131 executed by each of the applicants and in this regard, the Examiner's attention is directed to paragraph 7 thereof.

The Examiner's comment that the declaration filed under 37 C.F.R. §1.131 on November 26, 2002 (11/26/02) was ineffective to overcome the Bernstein et al, Barcelona, Peters, Brown, Small and Hill III references referred to in the Declaration is noted.

Applicants refer the Examiner's attention to the attached Declaration submitted under 37 C.F.R. §1.131 which has been executed by all the applicants (Exhibit 1).

This Declaration establishes that the manufacture and use of vending machines permitting Internet/www access by the public was conceived not later than December 26, 1995, as present in an United States Patent and Trademark mailroom date-stamped document, the original of which is present in the file of U.S. Application Serial No. 08/429,583, the benefit of which is claimed under 35 U.S.C. §120 in the present reissue application. Although, the Examiner alleged that such a paper is not a constructive reduction to practice, with which applicants respectfully disagree, applicants respectfully submit that it is at least evidence of conception. The conception of the invention is also independently confirmed in the attached Declaration of Dora Stroud (Exhibit 2), a former United States Patent and Trademark Office employee in the Applications Branch. It is noted that upon receiving the next (first and only) office action dated March 19, 1996, in the '583 application (which does not object to the paper filed December 26, 1995), Examiner Scaggs suggested employing a registered patent attorney to assist in correcting identified formal defects in the arrangement of the specification and recitations in the claims, applicants filed the 08/715,232 with assistance of patent counsel, on September 18, 1996, i.e., within the extended period for response to the Office Action of March 19, 1996. These facts establish that applicants were diligent in pursuing their invention to a constructive reduction to practice in the filing of the 08/715,232 application. The presence of conception (prior to the effective filing date of the references) and diligence toward (actual or constructive) reduction to practice entitles applicants to antedate each of the Bernstein et al, Barcello,

Peters, Brown, Small and Hill III references having 102(e) dates subsequent to applicants' date of invention.

In so antedating these references, the references do not qualify as "prior art" within the meaning of any section of 35 U.S.C. §102 and, hence, also cannot be used in combination with other references to support a rejection under 35 U.S.C. §103.

Thus, the rejections of each of the claims identified in paragraphs 10, 11, 12, 13, 14, 15 and 18 must fail insofar as they rely on at least one of the antedated references to support their rejection.

THE PETERS PATENT

Peters (U.S. Patent 5,769,269) was issued on an application filed April 23, 1996 and does not mention the Internet, nor visiting websites, but only teaches that a "telephone communications line 48 may be adapted to support an integrated service digital network (ISDN) . . ."; See, column 4, lines 49-57. There is no disclosure of using the ISDN to contact an Internet Service Provider (ISP) nor any other access to the Internet or websites.

Thus, even if Peters were given the benefit of the filing date of a predecessor application (Serial No. 08/234,143, filed April 28, 1994), which has not been shown by the office it does not contain a teaching of the claimed invention in such a manner as to form an express anticipation of the claimed invention.

HUEGEL

Huegel (U.S. Patent 5,239,480) has been cited as an express anticipation based on the allegations that Huegel teaches a vending machine, computer, etc. to connect to remote sites. However, Huegel does not permit the customer to connect to the Internet or websites (www) but, rather, only permits a customer to interact with and obtain tickets from the vending machine; See, column 3, lines 7-38. The system for effecting such ticket dispensing includes a self-service terminal having a central processor and being connected to a plurality of location processors, each location processor being associated with a respective location of an event; See, column 3, lines 39-57. Although the central processor communicates with the location processor to obtain availability of tickets, the consumer does not have access to the location processor during use of the self-service terminal; See, column 3, line 58 to column 4, line 42, especially, column 4, lines 24-33. Thus, the consumer is never provided access to the location processor, or in fact, is the consumer able to manipulate the self-service terminal to give any information to him outside of that associated with the selection and purchase of the dispensed item, i.e., tickets. Thus, the disclosure of Huegel fails to contain a disclosure of an express anticipation of the claimed features, especially access of the consumer to the Internet and websites as in independent claims 114, 127 and 130 (and claims dependent thereon).

GIL ET AL

Gil et al (U.S. Patent 6,477,514), like Huegel, is directed to a self-service machine, specifically for mail processing and storage. It also lacks any disclosure of a system or method of

operating a system which would permit access by customers to the Internet or websites. In this regard, applicants remind the Examiner that, in order to sustain the office's burden in demonstrating express anticipation of the claimed invention, the Examiner must rely on the express teachings of the reference, not the Examiner's interpretation of the reference. This is especially true when the Examiner equates "e-mail" with "Internet," a term not found in the disclosure of Gil. While the system of Gil et al permits the on board computer to communicate to a remote monitoring station (column 4, lines 18-32), the customer himself is not permitted access to the remote station or location; See, especially, column 11, lines 15-19; column 15, line 64 to column 16, line 5 and column 17, line 66 to column 18, line 44. Although the Examiner mentions "E-mail," there is no disclosure of the use of the "Internet" to transmit such mail. In fact, the disclosure of Gil et al is specific to a system where the Electronic Mail (E-mail) was delivered only between the user and a designated telephone number and not for interactive use; See, column 13, line 25-39, especially, lines 34-39. Thus, like Huegel, Gil et al fails to contain a disclosure of express anticipation of the claimed steps of independent claims 114, 127 and 130 (and claims dependent thereon) permitting access to the Internet and websites, not merely to transmit a fax or electronic mail to a single designated telephone number. Thus, there is nothing in Gil et al which resembles numerous computer databases and on-line services available for public access and retrieval of information even though "E-mail" is mentioned. Applicants remind the Examiner that at the time of the effective filing date of the Gil et al application, the Internet and the www were as yet, not widely known and may not have even been contemplated by Gil et al. Thus, although as of the date of this response, E-mail may be transmitted via the Internet, Gil et al fail to mention the same.

METTKE

Mettke is alleged to teach a vending machine. However, Mettke is nothing more than a personal computer, placed in a public place, with the “switch” to turn it on being a credit card reader and swipe device; See column 2, lines 1-28. There is absolutely no disclosure of a “vending machine” in Mettke and, thus, the reference fails to meet an expressly recited limitation of the claim. Again, it is what the references expressly disclose, not the Examiner’s dramatization of a disclosure, which makes a reference an anticipatory disclosure. If the Examiner would point out the words “Vending Machine” in Mettke, the undersigned would be most appreciative and the lack thereof would substantially expedite prosecution. In any event, if Mettke was characterized as vending Internet Services and requires a computer, modem, etc., to accomplish the same as characterized by the Examiner, where is the disclosure of the second computer, i.e., the claimed “computer” in combination with a “vending machine” as in the claimed invention since Mettke must include, as a part of the “vending of Internet service,” its own computer.

Applicants respectfully submit that even the Examiner’s characterization of the disclosure of Mettke, which is clearly silent as to the existence of a vending machine, cannot rise to the level of an express anticipation of the claimed rejection.

CONCLUSION

Having fully responded to the previous Office Action, favorable reconsideration and withdrawal of all rejections and passage of the application to issue are respectfully requested.

Respectfully submitted,


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ATTACHMENT I

37. (Thrice Amended) The vending machine of claim 32, further comprising:
at least one mechanism selected from the group including data storage unit, programmable
audio-video message storage unit, laser-disc, read-write CD-ROM, read only memory recording
medium, magnetic media and diskette for storage of data and recording, storage and playback of
audio and video signals,

wherein a customer is enabled respectively to upload and download audio and video signals
from and to said [audio-video] mechanism to and from websites and home pages, and to send and
receive data from and to said audio-video mechanism to and from other data transmitters or
receivers.

38. (Thrice Amended) The vending machine of claim 37, further comprising:
a camera connected to a computer for generating video signals; and
a microphone connected to a computer for generating audio signals, wherein said
microphone generated audio and camera generated video signals are recorded alone or in
combination with already recorded audio and visual signals by said at least one [audio-video]
mechanism.

41. (Amended) The vending machine of claim 40, wherein said at least one audio-
video [recording storage, and playback] mechanism is selected from the group consisting of data

fj
cont.
storage mechanism, laser-disc, read-write CD-ROM, and diskette, whereby said signals are recorded by said at least one audio-video mechanism and [dispenses] dispensed to the customer.

fj *swa* 102. (Twice Amended) The vending machine of claim 78 [32], wherein the computer displays a homepage or website, together with information from an Internet provider.

114. (Amended) A method of providing a customer with access to the Internet and websites [internet] via a vending machine, said method comprising:

- fj*
- 1.) providing a vending machine;
 - 2.) assembling [providing] a computer [associated with] in the vending machine, said computer being operatively connectable to the Internet and websites;
 - 3.) allowing [providing] access to the [internet] Internet and websites to a customer, said access comprising at least one of inserting money or credit card information into the vending machine and customer input of data to the computer.